



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/476,415	12/30/1999	DALE SANDBERG	3855.29	7821

21999 7590 03/08/2005

KIRTON AND MCCONKIE
1800 EAGLE GATE TOWER
60 EAST SOUTH TEMPLE
P O BOX 45120
SALT LAKE CITY, UT 84145-0120

EXAMINER

BLECK, CAROLYN M

ART UNIT	PAPER NUMBER
----------	--------------

3626

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/476,415

Applicant(s)

SANDBERG, DALE

Examiner

Carolyn M Bleck

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-29,31-38,40 and 41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-29,31-38,40 and 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 15 November 2004. Claims 21-29, 31-38, and 40-41 are pending. Claims 21-22 and 33-34 have been amended.

Specification

2. The objection to the specification is hereby withdrawn due to the response filed 15 November 2004. It is noted that support for the step of generating the customizable form comprising: selectively defining display specifications that relate to at least one of (i) a display of the healthcare procedures characteristically performed by the particular healthcare provider and (ii) a display of the healthcare diagnoses characteristically performed by the particular healthcare provider, and wherein the display specifications are based on individual user preferences is found at Fig. 4A-8 and page 13, line 19 through page 15, line 14.

Claim Rejections - 35 USC § 112

3. The rejection of claims 21-29, 31-38, and 40-41 under 35 U.S.C. § 112 is hereby withdrawn due to the amendment filed 15 November 2004.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 21-29, 31-38, and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans (5,924,074) in view of Feldon et al. (5,732,221) and Lavin et al. (5,772,585), for substantially the same reasons as given in the previous Office Action (paper dated 12 July 2004), and further in view of Provost et al. (6,341,265).

(A) As per claims 21-22 and 33-34, Lavin discloses a physician selecting a procedure from a list and adding the procedure to the procedure table list, wherein a predetermined fee is displayed in the fee column adjacent to the procedure list, and wherein the appropriate predetermined fee is associated with the selected procedures such that a patient bill may be easily and automatically generated after an office visit (Fig. 17, col. 13 lines 44-60).

Evans, Feldon, and Lavin fail to expressly disclose using the customizable form to display billing information prior to the rendering of the one of the procedures on the patient to allow the healthcare provider to advise the patient as to healthcare service to be rendered, including the most cost efficient healthcare alternative for the patient, and wherein the step for using the customizable to display billing information is performed during an examination of the patient, and wherein the step for using the customizable form to display billing information includes allowing the healthcare provider to selectively

adjust the cost of rendering the one of the procedures at the time of the examination of the patient.

Provost discloses a claim form for entering patient information, including insurance plan information, diagnosis codes, treatment codes, wherein the dollar amounts for a treatment code are displayed, wherein the dollar amounts can be displayed in a short amount of time which is limited by data transmission rates, wherein the patient is able to present because the dollar amounts can be collected from the patient in the office, wherein the physician may provide alternative treatments which are approved for payment by an insurance plan (Abstract, Fig. 3, 4A, 4B, col. 8 line 32 to col. 12 line 14).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Provost within the method taught collectively by Evans, Feldon, and Lavin with the motivation of reducing the number of insurance claims that are rejected by an insurance company (Provost; col. 2 lines 27-57) and decreasing the amount of time to determine whether a claim will be paid (Provost; col. 2 lines 27-57).

The remaining features are rejected for the same reasons given in the previous Office Action (paper dated 12 July 2004, sections 6(A) and 6(E)).

(B) Claims 23-29, 31-32, 33-38, and 40-41 have not been amended and are rejected for the same reasons given in the prior Office Action (paper dated 12 July 2004; sections 6(A)-6(E); pages 3-8).

Response to Arguments

6. Applicant's arguments with respect to claims 21-29, 31-38, and 40-41 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (703) 305-3981. After April 13, 2005, the Examiner can be contacted at (571) 272-6767. The

Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (703) 305-9588.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 306-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

9. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 872-9306 or (703) 872-9326

[Official communications]

Art Unit: 3626

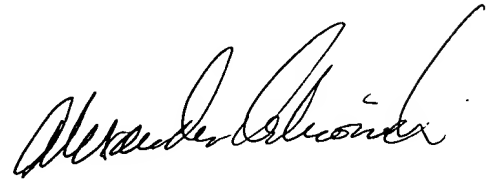
(703) 872-9327 [After Final communications labeled "Box AF"]

(703) 746-8374 [Informal/ Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th Floor (Receptionist).

CB
CB

February 28, 2005



ALEXANDER KALINOWSKI
PRIMARY EXAMINER